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REMARKS

Claims 1 through 12 are pending in the present application. Claims 1 through 12 are amended. No claims are added or cancelled hereby. The remarks below support applicant's assertion that the claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

35 U.S.C. § 101***Claims 1 - 4***

In the outstanding Office Action, claims 1 – 4 are rejected as being directed to a data structure or database and thus non-statutory under 35 U.S.C. 101. For at least the following reasons, these rejections are respectfully traversed.

Initially, Applicant points out that the Patent Office has "the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101... Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." M.P.E.P. 2106(I)(A). The Office Action fails to make such a *prima facie* case. The Office Action indicates that the subject matter of claims 1-4 is a data structure or database, but does not state how this conclusion is reached in light of the fact that the first limitation in claim 1 is "a server." This limitation cannot be ignored. "When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be

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considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9." M.P.E.P. 2106(II)(C) (emphasis added). Applicant asserts that claim 1 by its terms is thus limited to more than a mere data structure or database, and accordingly a *prima facie* rejection under 35 U.S.C. 101 has not been made.

Next, the Office Action asserts that claims 1 – 4 are directed merely to abstract ideas. A claim is directed to an abstract idea if it lacks "some claimed practical application." M.P.E.P. 2106(IV)(B)(1). Claim 1 includes the limitation of providing "information to the server program to assemble a web page customized for each identified user." (Claim 1, as filed, lines 10-11.) This means that the structure of claim 1 uses the identification of a client computer to invoke specific logical components associated with the client to create and present to that client computer its own customized web page. Respectfully, applicant asserts that this is a very practical application.

Finally, the Office Actions asserts that claims 1 – 4 are intangibly embodied. Respectfully, applicant asserts once again that claim 1 is limited to "a server" and various procedures "resident on the server" (e.g., claim 1, lines 2, 6, and 9). Applicant asserts that these are tangible embodiments as contemplated by 35 U.S.C. 101. (This is analogous to when descriptive material is recorded on some computer-readable medium, which according to M.P.E.P. 2106(IV)(B)(1), renders the descriptive material structurally and functionally interrelated to the medium and hence statutory.)

Claim 1 is thus more than an abstract idea and is tangibly embodied. Claims 2 – 4 depend from and contain all of the limitations of claim 1, and therefore must be statutory for the same reasons supporting claim 1. Therefore, applicant asserts that claims 1-4 are statutory under 35 U.S.C. 101.

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Claims 5-8

In the outstanding Office Action, the Examiner rejected claims 5 – 8 as being directed to an abstract idea and thus non-statutory under 35 U.S.C. 101. Applicant has amended claim 5, above, to support the assertion that that claim, and the claims depending therefrom, represent statutory subject matter.

Claim 5, as amended, is directed to the process of constructing a customized web page including: (i) providing logical components for selection by a user (claim 5, as presented above, lines 3-4), (ii) recording, on a server, the user's id and her selected components (claim 5, as presented above, lines 6-7), (iii) subsequently identifying the user when she calls the server (claim 5, as presented above, lines 8-9), and (iv) once identified, assembling her selected components into a customized web page to be displayed on her computer (claim 5, as presented above, lines 12-14). That is, the user chooses elements she would like to include in her customized web page, and this information is stored in the server. When she subsequently logs into the server again, the server uses her prior selection to assemble her customized web page – anytime and anywhere she logs in to the server.

This is much more than the mere operation of an algorithm or mathematical calculations. Specific steps are performed to achieve a concrete result – "the server assembling for display a web page customized for the identified user" (claim 5, as presented above, lines 13-14). Data, namely the addresses of logical components are transformed into a structure from which a web page is created, the product being the web page itself. This is similar to "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, [which] constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' - a

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final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades" found statutory in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998). Accordingly, applicant argues that claim 5, and claims 6-8 which depend from claim 5, are directed to statutory subject matter.

Claims 9-12

In the outstanding Office Action, the Examiner rejected claims 9 – 12 as being directed to an intangible media and an abstract idea, and thus non-statutory under 35 U.S.C. 101. Applicant has amended claim 9, above, to support the assertion that claim 9, and the claims depending therefrom, represent statutory subject matter.

Claim 9, as amended, is now directed to a computer-readable storage medium having stored thereon a number of functional software programs and procedures. As such, the claim is directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Thus, claim 9 as amended, and claims 10-12 which depend from claim 9, satisfy the requirements of 35 U.S.C. 101.

Title of the Invention

The title of the invention has been objected to as being non-descriptive and insufficiently precise. Applicant has amended the title of this application in response to this objection, and respectfully suggests that the title now complies with the requirements therefor.

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The Disclosure

The Examiner has objected to the specification of the present application, requesting that applicant update the reference to documents in the "Related Applications" section. Applicant has amended the specification accordingly.

35 U.S.C. 112

The Examiner has rejected claims 1-12 under 35 U.S.C. 112 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that the term 'logic component' is not understood. Applicant has amended claims 1-12 to replace "logic component" with –logical component–, the later being well defined in the specification as filed.

35 U.S.C. 103(a)

The Examiner has rejected claims 1-12 as being unpatentable in light of U.S. Patent 6,813,489 (hereinafter referred to as Wu et al.) Applicant respectfully traverses this rejection. The priority date of the Wu et al. reference is March 1, 2002. However, the priority date for the present application is May 1, 1997, more than one year prior to the priority date of the Wu et al. patent. Accordingly Wu et al. does not meet the definition of "prior art" as that term is used in 35 U.S.C. 103, and cannot therefore be applied against the present application.

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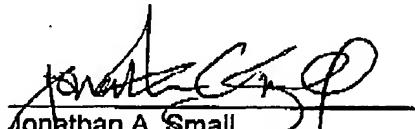
Conclusion

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,



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